

Remarks

Claims 1-11 and 13-35 are pending. Claims 1-7, 9-11, 13-17 and 19-35 stand rejected under 35 USC §102(b). Claims 8 and 18 stand rejected under 35 USC §103(a). Independent claims 1, 3, 13, 24, 26, 30 and 33 have been amended. Claim 8 is canceled. Neither new claims nor new subject matter was added. Applicants respectfully traverse the rejections and assert that all claims are now in condition for allowance as more specifically set forth below.

102 Rejections

The Office Action has rejected claims 1-7, 9-11, 13-17 and 19-35 as being anticipated by Yoshikawa (US Pat N 6,061,516). The office action asserts that Yoshikawa teaches all the elements. Independent claims 1, 3, 13, 24, 26, 30 and 33 have been amended to include subject matter not taught by Yoshikawa. Amended claims 1, 3, 13, 24, 26, 30 and 33 now recite, in pertinent part, "...wherein the one or more screen location identifiers include a screen number". The Office Action, on page 8, concedes that Yoshikawa does not teach the use of a screen number. Accordingly, amended independent claims 1, 3, 13, 24, 26, 30 and 33 recite elements not taught or disclosed in Yoshikawa and are therefore allowable over Yoshikawa for at least that reason.

However, it should be noted that the recitations above were previously included in dependent claim 8. As discussed below in the 103 Rejections section, the combination of references fails to render these independent claims unpatentable.

Dependent claims 2, 4-7, 9-11, 14-23, 25, 27-29, 31-32 and 34-35 depend from an allowable amended claim 1, 3, 13, 24, 26, 30 or 33 and are also allowable for the same reasons.

103 Rejections

The Office Action has rejected claims 8 and 18 under 35 USC §103(a) as being obvious under Yoshikawa in view of either IBM Technical Disclosure Bulletin, "Screen Design Facility", July 1997 ("IBM") or Janay (US Pat. 5,530,961) ("Janay"), respectively. Applicants respectfully traverse these rejections.

Claim 8

Although claim 8 has been canceled, its subject matter has been included in independent claims 1, 3, 13, 24, 26, 30 and 33. The Office Action rejects claim 8 under 35 USC §103(a) as being obvious under Yoshikawa in view of IBM. To the extent the Examiner intends to apply the same rejection to the independent claims 1, 3, 13, 24, 26, 30, and 33, Applicants traverse this rejection in advance.

The Office Action concedes on page 6 that the use of a screen number is not taught by Yoshikawa. The Applicant concurs with the Office Action's conclusions. It is also true that Yoshikawa offers no implied teaching, suggestion or motivation to use a screen number in conjunction with identifying, determining or storing each screen field. However, it is also true that IBM offers no implied teaching, suggestion or motivation to utilize a screen number other than to prevent human error. A reference must provide an explicit or implicit suggestion, teaching or motivation in order to be §103 prior art. See, *In Re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q2D (BNA) 1614 (Fed. Cir. 1999) (Placing a pumpkin face on an orange trash bag not obvious under 35USC§103(a) without finding of suggestion, teaching or motivation in the reference).

In IBM, the method disclosed is one for manually designing screen content directly on a screen terminal. The use of a screen number in IBM is to prevent human error in case the designer mistakenly assigns the same screen name to multiple screens. (See Page 1). In the Yoshikawa, the screen field location identifiers are being copied from one computer to another. (Col . 6, l. 26-29). They are not being assigned to screens manually. Therefore there is no reason to be concerned about human error because such screen definition information is being created by a computer (i.e. the use of XMAPE2E or other system to generate the screen definition information file)(Col. 1, l 26-35). Furthermore, Yoshikawa teaches no reason why a screen number is necessary and as such, inclusion of a screen number would be superfluous since it is not needed in Yoshikawa. IBM only teaches the use of screen numbers in case of the erroneous creation of duplicate screen names and since there is no danger of duplicate screen names

in Yoshikawa, there would be no suggestion at the time of the invention to modify Yoshikawa to include a screen number as taught in IBM. Still further, an argument based on the theory that “it was obvious to try” fails as an obviousness rejection. See, *In re Fine*, 837 F.2d 1071, U.S.P.Q.2D 1596 (Fed. Cir 1988), especially in this case where there was no reason to modify Yoshikawa since it does not suffer from the issue being addressed by the screen number in IBM.

Because the cited combination of Yoshikawa and IBM fails due to the lack of motivation to modify Yoshikawa based on IBM, the claims are allowable over the cited combination for at least these reasons. Accordingly, for at least these reasons, amended claims 1, 3, 13, 24, 26, 30 and 33 are allowable over any potential combination of Yoshikawa in view of IBM.

Claim 18

As noted above for the §102 rejections, claim 18 that has been rejected under 35 USC §103(a) depends from allowable base claim 13 and is also allowable over the cited references for at least the same reasons.


Conclusion

Applicants assert that the application including claims 1-7, 9-11 and 13-35 is in condition for allowance. Applicants respectfully request reconsideration in view of the remarks above, and further requests that a Notice of Allowability be provided. Should the Examiner have any questions, please contact the undersigned.

No fees are believed due. However, please charge any additional fees or credit any overpayment to Deposit Account No. 50-3025.

Respectfully submitted,

Date: August 4, 2005



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